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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/273,102	03/19/1999	STEVEN C. GLASSMAN	3765	6616

758 7590 05/07/2002

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EXAMINER

FELTEN, DANIEL S

ART UNIT PAPER NUMBER

3624

DATE MAILED: 05/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/273,102

Applicant(s)  
Glassman et al

Examiner  
Daniel Felten

Art Unit  
3624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 23, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 3-6, 11-17, and 19-22 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 3-6, 11-16, and 22 is/are allowed.
- 6) ☒ Claim(s) 17 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## DETAILED ACTION

1  
2 1. Receipt is acknowledged of the amendment filed January 23, 2002 amending claims 6,  
3 11, 12, 15 and 22. Claims 3-6, 11-17 and 19-22 remain pending in the application and are  
4 presented to be examined upon their merits.

### *Response to Arguments*

5  
6  
7 2. Applicant's arguments regarding claims 17 and 19-21 filed January 23, 2002 have been  
8 fully considered but they are not persuasive.

#### **Regarding claims 17 and 19-21:**

9  
10  
11 The applicant maintains the position that the identifying information and the values of  
12 transforming are both provided by the party seeking the refund. (see Applicant's Remarks, page  
13 6).

14 The examiner takes issue with applicant's assertions because the limitations as cited and  
15 set forth in claim 17 are **not**, as the applicant has argued, limitations regarding the functionality  
16 of the computer readable medium within the system, but merely **instructions** provided by the  
17 computer readable medium to the computer system to provide a refund. It is respectfully  
18 requested that the applicant read claim 17 preamble again:

1       “ 17.    A computer readable medium having computer instructions encoded thereon for directing a  
2       computer system to provide the refund in an electronic commerce system, the computer instructions  
3       providing instructions for:...”  
4

5       There is no limitation within claim wherein the computer readable medium must directly  
6       remit the identifying information and the values of transforming from the party seeking the  
7       refund, or that the computer system is limited to a two party process. Hiroya's system receives  
8       the values for transforming the information and identifying the party seeking the refund from the  
9       refund initiation process which acquires the aforementioned values indirectly from a certificate  
10      authority. The process to obtain a refund is directly initiated by the party seeking the refund  
11      (client) to the entire computer system, as it is in claim 17. Thus for the aforementioned reason(s)  
12      the 35 U.S.C. 103 rejection as set forth in claim 17 is maintained.  
13

14                                   ***Allowable Subject Matter***

15      3.       Claims 3-6, 11-16 and 22 are allowed.

16      4.       The following is a statement of reasons for the indication of allowable subject matter:

17      **Regarding claims 11-16:**

18              The applicant discloses in independent claim 11, a method of providing a refund in an  
19      electronic commerce system, comprising the step of:

1        “...using by the first party, the values for transforming the information identifying  
2        the first party into the first value to transform the information identifying the first  
3        party into a second value...”

4        The closest prior art is the shopping system invention of Hiroya (EP 0 848 343 A2).

5        Hiroya’s system does not disclose receiving values for identifying the party seeking a refund (or  
6        first party, or client) by the party seeking the refund (or the first party), but by a certificate of  
7        authority. Thus the aforementioned underlined limitation renders the independent claim and  
8        depending claims non-obvious.

9  
10      **Regarding claims 3-6 and 22:**

11      The applicant discloses in independent claim 22, a system comprising:

12      “...the second system further adapted to receive from the party seeking the refund the  
13      identification of the recipient of the scrip and values enabling transformation by the  
14      second system of the identification of the recipient of the scrip, and to utilize the received  
15      values to verify that the party seeking the refund is the recipient of the scrip.”

16      The closest prior art is method for conducting computerized commerce of Manasse. Manasse’s  
17      system does not disclose either separately or in combination the aforementioned underlined  
18      feature inasmuch as the second system receives values enabling transformation *by the second*  
19      *system...and to utilize the received transformed values to verify....*. In Manasse’s invention, the

1 vendor locally validates the scrip to prevent customer fraud, however there is no refund method  
2 as described above.

3  
4  
5 **Conclusion**

6  
7 5. Any inquiry concerning this communication or earlier communications from the examiner  
8 should be directed to **Daniel S. Felten** whose telephone number is (703) 305-0724. The  
9 examiner can normally be reached between the hours of 7:00AM to 5:30PM Monday-Thursday.  
10 Any inquiry of a general nature relating to the status of this application or its proceedings should  
11 be directed to the Customer Service Office (703) 306-5631, or the examiner's supervisor  
12 **Vincent Millin** whose telephone number is (703) 308-1065.

13  
14 6. Response to this action should be mailed to:

15  
16 Commissioner of Patents and Trademarks

17 Washington, D.C. 20231

18  
19 for formal communications intended for entry, or (703) 305-0040, for informal or draft  
20 communications, please label "Proposed" or "Draft".

21 Communications via Internet e-mail regarding this application, other than those under 35  
22 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be  
23 addressed to [daniel.felten@uspto.gov].


24 All Internet e-mail communications will be made of record in the application file. PTO

1 employees do not engage in Internet communications where there exists a possibility that  
2 sensitive information could be identified or exchanged unless the record includes a properly  
3 signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly  
4 set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and  
5 Trademark on February 25, 1997 at 1 195 OG 89.

6  
7 

8 **DSF**

9 **May 2, 2002**

  
VINCENT MILLIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100